

REMARKS

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-65 are pending. Claim 1 is amended, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claim and the remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. RESPONSE TO RESTRICTION REQUIREMENT

The November 20, 2002 Office Action required an election under 35 U.S.C. § 121 from:

Group I: Claims 1-40, drawn to coating method, classified in class 427, subclass 483.

Group II: Claims 41-61, drawn to coating apparatus, classified in class 118, subclass 620+.

Group III: Claims 62, 64, drawn to powder fabrication method, classified in class 264, subclass 12; and

Group IV: Claims 63, 65, drawn to apparatus for powder fabrication, classified in class 239, subclass 79.

In response to the Restriction Requirement, applicants provisionally elect, **with traverse**, for further prosecution in this application, the invention of Group I, claims 1-40 drawn to coating method, classified in class 427, subclass 483. Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

The present invention relates to a method of and apparatus for depositing material, preferably a film, on a substrate. Also, the present invention relates to a method of and apparatus for fabricating a powder, preferably an ultrafine powder, using the method, wherein the aerosol droplets react homogeneously in the gas phase to form a powder.

Applicants respectfully urge that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn or at least modified.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search for all of the groups overlaps. For example, the apparatus of Claims 63 and 65 in Group IV utilizes the method of claims 1-40 in Group I. The present claims represent a web of knowledge and continuity of effort that merits examination in a single application. Thus, reconsideration and modification the Restriction Requirement are warranted.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as to the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the three groups are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the restriction requirement are requested, and an early action on the merits is earnestly solicited.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, an interview with the Examiner is respectfully requested, prior to issuance of any paper other than a Notice of Allowance; and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

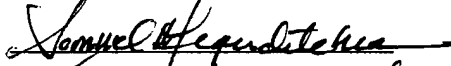
CONCLUSION

In view of the amendment and remarks herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance, or an interview at a very early date with a view to placing the application in condition for allowance, are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

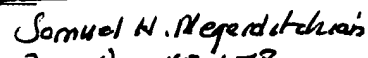


for

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VERSION WITH MARKINGS SHOWING CHANGES MADE

1. (Amended) A method of depositing in situ [material, preferably] a solid film [,] on a substrate, comprising the steps of:

providing a substrate;

heating the substrate such as to provide for deposition of a solid film;

[generating an aerosol comprising droplets of a material solution;]

providing a nozzle unit for delivering an [the] aerosol to the substrate, the nozzle unit including at least one outlet through which a directed flow of the aerosol is delivered and at least one electrode;

generating an aerosol comprising droplets of a material solution upstream of the nozzle unit;

[charging the aerosol droplets with a positive or negative charge;]

providing a flow of the aerosol through the nozzle unit so as to deliver a directed flow of the aerosol from the at least one outlet; and

generating an electric field between the substrate and the at least one electrode such that the aerosol droplets are charged with a positive or negative charge and the directed aerosol flow is attracted towards the substrate.